

REMARKS

Claims 1-10 were pending. By virtue of this response, claims 1, 2, and 9 are amended. Claim 11 is newly added. After entry of this amendment, claims 1-11 remain pending in this application. Amendment and cancellation of certain claims is not to be construed as a dedication to the public of any of the subject matter of the claims as previously presented. No new matter is added.

Support for the amendment to claim 1 may be found throughout the specification, as filed. For example, the amendment to include “wherein moving the unit into the goal area of the first player establishes the first player as the winner of the game” may be found at paragraph [0014].¹ Support for removal of “magnetic” in claim 1 may be found at paragraph [0012]. Support for new claim 11 may be found in paragraph [0014] and figures 1-6.

Statement of Substance of the Interview

Applicants thank Examiners Dimitry Suhol and Seng Lim for the courtesy of the telephone interview conducted on October 7, 2009. Also present for the call were Applicants representatives, Michael Byström of Albihns AB and Brian Ho of Morrison & Foerster. Claim 1 and the Brotz reference (US 5,213,338) were discussed. In particular, Brotz at 2:2-20 and 5:9-11 was discussed. Additionally, the rejections under 35 USC 112 were discussed. Applicants proposed amending the claims substantially as presented herein. Applicants believe that agreement was reached regarding Brotz disclosing a game in which the player with the “most brain waves” brain waves wins and Brotz not teaching or suggesting a game in which the winner was determined as the player with lower brain wave frequencies.

The Examiners also requested a brief discussion of patentability under the standards of *In re Bilski*.

¹ Throughout this response, Applicants cite to the patent application publication, US 2007/0123350.

Claim Rejections Under 35 USC §112*Written Description*

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The Examiner stated that the term “goal area of a [sic] the first player” could be interpreted to mean moving the object towards the first player’s own goal area, for which the applicant does not have support. The Examiner also noted that the claim 1 was originally directed to moving the object towards the second player.

MPEP 2163 states: “To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention.” MPEP 2163.03 provides the test as follows: “does the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed.”

Applicants note that claim 1 has been amended to include the term “wherein moving the unit into the goal area of the first player establishes the first player as the winner of the game.”

As cited above, the proper test for written description depends on an analysis of what the description conveys to a person of skill. Applicants respectfully assert that the Examiner’s analysis of the difference between the original claims and the amended claims is improper. Rather, the disclosure must be reviewed to determine compliance with the written description requirement.

With respect to the disclosure, paragraph [0014] states: “[t]he processor 22 may be programmed so that the ball 38 moves in the x-direction towards the player with the highest theta and alpha wave frequency. In other words, the calmest player is likely to win the game when the ball 38 moves into the segment 14 or 20.” The discussion in paragraph [0014] is directed to the embodiment of the FIGs. 1-6. *See Disclosure at [0010].* In the embodiment of the figures, the second player is situated on the same side as the goal area of the first player. The second sentence cited above, in particular, makes clear that it is the goal area that is relevant for winning the game,

not the direction of the second player, *per se*. Applicants assert that one skilled in the art of game design would fully appreciate that a goal area may be separate from the position of the players (*e.g.*, the first player's goal may be situated near the first player or equidistant from the players) and that the person of skill would fully appreciate that applicants were in possession of the claimed invention, as amended.

Applicants therefore respectfully assert that written description exists for the claim as amended. Applicants request that the rejection under 35 USC 112 (written description) be withdrawn.

Enablement

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The Examiner stated that the disclosure does not teach how to measure mental state of the players.

While applicants believe that the previously presented claim was enabled, applicants have amended claim 1 to strike the language relating to mental state, in order to further prosecution.

Applicants request that the rejection under 35 USC 112 (enablement) be withdrawn.

Claim Rejections Under 35 USC §103

Brotz in view of Ohlschlager

Claims 1-6 and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brotz (U.S. Patent No. 5,213,338) in view of Ohlschlager (U.S. Patent No. 3,712,617).

In addition to the following remarks, applicants respectfully reiterate the remarks made in the Response dated May 11, 2009.

As noted above, Applicants believe that the Examiners agreed that Brotz fails to teach or suggest a game in which the winner was determined as the player with lower brain wave

frequencies. In particular, Applicants believe that Brotz teaches the exact opposite and determines a winner based on the player with the most brain waves (*i.e.*, highest frequencies). *See* Brotz at col. 2, lines 52-56; col. 5, lines 9-11; claim 6. The brief discussions of relaxation in Brotz, cited by the Examiner², are related to non-player specific relaxation and are not inconsistent with its teachings of determining a winner based on higher frequencies. *See* Brotz at col. 2, lines 2-20.

Applicants also assert that a person of skill would not find it obvious to modify Brotz to determine a winner based on lower brain wave frequencies. Based on the significance of brain wave frequency, one of skill would recognize that principle of operation of the game in Brotz is based on assigning the player with the higher brain wave frequencies as the winner. Modifying Brotz's principle to the exact opposite criteria would not be obvious. Doing so would be akin to modifying the rules of a foot race so that the slowest, rather than the fastest, runner would be determined as the winner. MPEP 2143.01(VI) makes clear that the principle of operation is not a design element that would be obvious to modify.

For these reasons and the reasons stated in the Response of May 11, 2009, applicants request that this rejection under 35 USC 103 be withdrawn.

Brotz in view of Ohlschlager and McCaslin

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brotz (U.S. Patent No. 5,213,338) in view of Ohlschlager (U.S. Patent No. 3,712,617) as applied to claim 1 and further in view of McCaslin (U.S. Patent No. 4,332,385).

Neither Ohlschlager or McCaslin cure the deficiencies of Brotz discussed above. Accordingly, applicants request that this rejection under 35 USC 103 be withdrawn.

² Brotz at col. 1, 39-41.

In re Bilski

Applicants respectfully assert that the present claims are directed to permissible patentable subject matter under 35 USC 101, under the standards established by *In re Bilski*. Applicants refer to the “Interim Examination Instructions For Evaluating Subject Matter Eligibility Under 35 U.S.C. § 101,” dated August 24, 2009. With respect to section II.B of those guidelines, applicants note that the present claims involve substantive use of a machine in all three steps of claim 1 and therefore meets the “machine-or-transformation” test. Notably, use of a machine in each step is not merely “field-of-use” or “extra-solution” in nature. For example, use of a machine is required to measure the brain wave frequencies of the players (first step) and translate those measurements into appropriate movement of a unit (steps two and three).

Applicants respectfully assert that the present claims are directed to patentable subject matter.

CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark Office determines that an extension and/or other relief is required, Applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing **Docket No. 616562000800**. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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